



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christopher J. deSimone, Lucian M. Hand, Gi Jeong Kim, Seung Mo Kim, Jin An Lee

Assignee: Amkor Technology, Inc.

Title: Nonexposed Heat Sink For Semiconductor Package

Serial No.: 09/513,067 Filing Date: February 24, 2000

Examiner: C. Luu Group Art Unit: 2825

Docket No.: AMK-AB0928 (AB-928 US)

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San Jose, California  
July 2, 2003

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COMMISSIONER FOR PATENTS  
PO BOX 1450  
ALEXANDRIA, VIRGINIA 22313-1450

**REQUEST FOR ACTION ON PETITION FOR RETROACTIVE LICENSE**

Dear Sir:

A Petition for Retroactive License Pursuant to 37 CFR Section 5.25 was filed with the application on February 24, 2000. A copy of the request is attached hereto as Tab A along with a copy of a return receipt postcard indicating that the Petition was received by the USPTO.

No decision has been received by the undersigned. Accordingly, it is requested that the Examiner investigate the status of the Petition, and provide a status report in the next Office Action or in a Notice of Allowance.

If a decision has been issued, please have a copy of the decision mailed or faxed (408 451-5908) to the undersigned. If no decision has yet been made, it would be appreciated if the Examiner would contact the relevant persons so that the Petition will be considered.

Please do not allow a patent to issue until a decision granting the Petition has been made.

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LICENSING & REVIEW

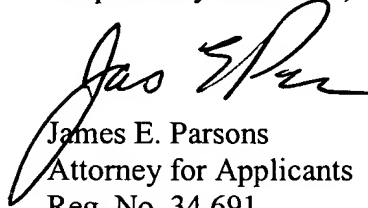
Please direct questions or comments to the undersigned at 408 451-5906.

EXPRESS MAIL LABEL NO:

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Customer No. 022888

Respectfully submitted,



James E. Parsons  
Attorney for Applicants  
Reg. No. 34,691

February 24, 2000

Box Patent Application  
Assistant Commissioner for Patents  
Washington, D. C. 20231

Enclosed herewith for filing is a patent application, as follows:

Inventor(s): de Simone, Christopher J.; Hand, Lucian M.; Kim, Gi Jeong; Kim, Seung Mo; Lee, Jin An  
Title: Nonexposed Heat Sink For Semiconductor Package

X Return Receipt Postcard  
X This Transmittal Letter (in duplicate)  
10 page(s) Specification (not including claims)  
3 page(s) Claims  
1 page Abstract  
8 Sheet(s) of Drawings consisting of Figures 1, 2, 3, 4, 5A, 5B, 5C, 6A, 6B, 7A, 7B, 8, 9A, 9B, 10A, and 10B  
3 page(s) Declaration For Patent Application and Power of Attorney signed by de Simone, Christopher  
3 page(s) Declaration For Patent Application and Power of Attorney signed by Kim, Gi Jeong; Kim, Seung Mo; Lee, Jin An  
1 page(s) Recordation Form Cover Sheet (in duplicate)  
3 page(s) Assignment signed by Kim, Gi Jeong; Kim, Seung Mo; Lee, Jin An  
3 page(s) Assignment signed by de Simone, Christopher  
31 Copy of Korean Patent Application 99-13130 (uncertified)  
2 Petition for Retroactive License Pursuant to 37 C.F.R. § 5.25  
2 Declaration Of James E. Parsons In Support Of Petition For Retroactive Foreign Filing License  
2 Declaration Of Taebok Jung In Support Of Petition For Retroactive Foreign Filing License  
2 Declaration Of Christopher de Simone In Support Of Petition For Retroactive Foreign Filing License

**CLAIMS AS FILED**

For	Number Filed		Number Extra		Rate		Basic Fee
Total Claims	12	-20	=	0	x	\$18.00	= \$ 0.00
Independent Claims	3	-3	=	0	x	\$78.00	= \$ 0.00
<input type="checkbox"/>	Fee of _____ for the first filing of one or more multiple dependent claims per application						\$
<input checked="" type="checkbox"/>	Fee for Petition for License Pursuant to CFR § 5.25						\$ 130.00

Please make the following charges to Deposit Account 19-2386:

- ☒ Total fee for filing the patent application in the amount of \$ 820.00  
☒ The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account 19-2386.

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Austin, TX  
Newport Beach, CA  
San Francisco, CA

**EXPRESS MAIL LABEL**  
NO:  
EL276258271US

Respectfully submitted,

*James E. Parsons*  
James E. Parsons  
Attorney for Applicant(s)  
Reg. No. 34,691



**BOX PATENT APPLICATION**  
**ASSISTANT COMMISSIONER FOR PATENTS**  
**WASHINGTON, D.C. 20231**

Inventors: de Simone, Christopher J.; Hand, Lucian M.; Kim, Gi Jeong; Kim, Seung Mo; Lee, Jin An  
Title: Nonexposed Heat Sink For Semiconductor Package  
Attorney Docket: AB-928 US

**ENCLOSED:**

<u>X</u>	This Return Receipt Postcard
<u>X</u>	Transmittal Letter (in duplicate)
<u>10</u>	Page(s) Specification (not including claims)
<u>3</u>	Page(s) Claims
<u>1</u>	Page Abstract
<u>8</u>	Sheet(s) of Drawings consisting of Figures 1, 2, 3, 4, 5A, 5B, 5C, 6A, 6B, 7A, 7B, 8, 9A, 9B, 10A, and 10B
<u>3</u>	Page(s) Declaration For Patent Application and Power of Attorney signed by de Simone, Christopher
<u>3</u>	Page(s) Declaration For Patent Application and Power of Attorney signed by Kim, Gi Jeong; Kim, Seung Mo; Lee, Jin An
<u>1</u>	Page(s) Recordation Form Cover Sheet (in duplicate)
<u>3</u>	Page(s) Assignment signed by Kim, Gi Jeong; Kim, Seung Mo; Lee, Jin An
<u>3</u>	Page(s) Assignment signed by de Simone, Christopher
<u>31</u>	Copy of Korean Patent Application 99-13130 (uncertified)
<u>2</u>	Petition for Retroactive License Pursuant to 37 C.F.R. § 5.25
<u>2</u>	Declaration Of James E. Parsons In Support Of Petition For Retroactive Foreign Filing License
<u>2</u>	Declaration Of Taebok Jung In Support Of Petition For Retroactive Foreign Filing License
<u>2</u>	Declaration Of Christopher de Simone In Support Of Petition For Retroactive Foreign Filing License

JEP/KAM

February 14, 2000

VIA EXPRESS MAIL NO : EL2/62582/1US

Jc625 U.S. PTO  
09/513067  
02/24/00

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MAR 07 2000



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): de Simone, Christopher J., et al.  
Assignee: Amkor Technology, Inc. and Anam Semiconductor, Inc.  
Title: NONEXPOSED HEAT SINK FOR SEMICONDUCTOR PACKAGE  
Serial No.: TBD Filed: TBD  
Examiner: TBD Group Art Unit: TBD  
Docket No.: AB-928 US

San Jose, California  
February 24, 2000

ATTN: LICENSING AND REVIEW  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D. C. 20231

**PETITION FOR RETROACTIVE LICENSE PURSUANT  
TO 37 C.F.R. § 5.25**

Dear Sir:

The applicants respectfully request a retroactive foreign filing license under the provisions of 37 C.F.R. § 5.25, and further request that the petition be granted retroactively to April 14, 1999.

The present petition is being filed because one aspect of the disclosure of the present application, in particular, the concept of a nonexposed heat sink for an integrated circuit package, was conceived in the United States. This concept was subsequently included in Korean Patent Application No. 99-13130 with other concepts that were invented in Korea. The Korean application was filed in the Korean Industrial Property Office ("KIPO") on April 14, 1999 without a license for foreign filing. A copy of the Korean application is filed herewith.

In support of the petition, the applicants are submitting declarations of Christopher de Simone, James E. Parsons and Tae Bok Jung. In accordance with 37 C.F.R. 5.25 (a)(3)(i)-(iii), the facts set forth in the declarations establish that: (1) the subject matter was not under a secrecy order at the time it was filed abroad; (2) the subject matter is not currently under a

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SKJERVEN, MORRILL,  
McPHERSON, FRANKLIN  
& FRILL LLP

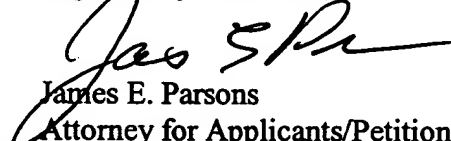
25 METRO DRIVE  
SUITE 700  
SAN JOSE, CA 95110  
(408) 453-9200  
FAX (408) 453-7979

secrecy order; and (3) a license was diligently sought after discovery of the proscribed foreign filing. The declarations also provide an explanation as to why the material was inadvertently filed abroad without the required license under § 5.11 first having been obtained.

The fee required for this Petition for Retroactive License (37 C.F.R. § 1.17(h)) and any additional fees which may be required may be charged to Deposit Account 19-2386. A duplicate of this petition is enclosed herewith.

Questions concerning this petition may be directed to the undersigned at phone number (408) 453-9200, extension 1315.

Respectively submitted,

  
James E. Parsons  
Attorney for Applicants/Petitioners  
Reg. No. 34,691

EXPRESS MAIL LABEL NO:  
EL276258271US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): de Simone, Christopher J., et al.  
Assignee: Amkor Technology, Inc. and Anam Semiconductor, Inc.  
Title: NONEXPOSED HEAT SINK FOR SEMICONDUCTOR PACKAGE  
Serial No.: TBD Filed: TBD  
Examiner: TBD Group Art Unit: TBD  
Docket No.: AB-928 US

San Jose, California  
February 24, 2000

ATTN: LICENSING AND REVIEW  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D. C. 20231

**DECLARATION OF JAMES E. PARSONS IN SUPPORT OF PETITION FOR  
RETROACTIVE FOREIGN FILING LICENSE**

I, James E. Parsons, declare as follows.

1. I am a registered U.S. patent attorney (no. 34,691). My office is at Skjerven, Morrill, MacPherson, Franklin & Friel LLP, 25 Metro Drive, Suite 700, San Jose, California, 95110 (phone (408) 453-9200).

2. In early August 1999, I became responsible for preparing an United States patent application for Amkor Technology, Inc. ("Amkor") and Anam Semiconductor Inc. ("Anam"). Amkor is based in Chandler, Arizona. Anam is based in Korea. The subject matter of the disclosure was a nonexposed heat sink for an integrated circuit package. At the time, I understood that the inventors were Christopher de Simone and Lucian Hand of Amkor, and Gi Jeong Kim, Seung Mo Kim, and Jin An Lee of Anam.

2. On August 4, 1999, I inquired with Anam as to whether the subject matter was included in a patent application filed in another country. On or about September 2, 1999, I learned from Anam that the idea of a nonexposed heat sink was included in Korean Patent Application No. 99-13130 along with several other package and leadframe ideas. The Korean patent application was filed on April 14, 1999. I had no involvement with the filing of that Korean application.

3. I received an English language version of the Korean application in late September or early October 1999. I saw that the idea of a nonexposed heat sink was one part of an application that included numerous package and leadframe ideas. I subsequently worked on a draft of a U.S. application based and sent a draft to the inventors on October 8, 1999.

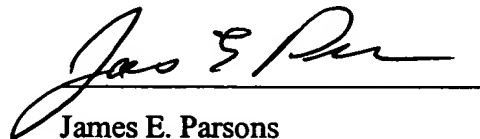
4. Between mid-November and December 9, 1999, after one or both of Messrs. de Simone and Hand had gone through the draft, I confirmed with them that the idea of a nonexposed heat sink was initially conceived in the United States by Mr. de Simone, but was subsequently tested and developed further with Anam engineers in Korea when Mr. de Simone visited Anam's facility.

5. Thereupon, I set about to have a petition for a retroactive filing license prepared.

6. The present petition was timely filed after a reasonable period of investigation of the facts and communications with the persons involved. The amount of time taken was reasonable given that translations had to be obtained of the Korean application and that Anam's patent staff is located in Korea.

7. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application or any patent issuing therefrom.

Date: 2/24/00

  
James E. Parsons

EXPRESS MAIL LABEL NO:  
EL276258271US





**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): de Simone, Christopher J., et al.  
Assignee: Amkor and Anam (jointly)  
Title: NONEXPOSED HEAT SINK FOR SEMICONDUCTOR PACKAGE  
Serial No.: TBD Filed: TBD  
Examiner: TBD Group Art Unit: TBD  
Docket No.: AB-928 US

San Jose, California

Date

01/14/00

ATTN: LICENSING AND REVIEW  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D. C. 20231

**DECLARATION OF TaeBok Jung IN SUPPORT OF PETITION FOR  
RETROACTIVE FOREIGN FILING LICENSE**

I, **TaeBok Jung**, declare as follows.

1. I am a citizen and resident of Korea. I am employed by Anam Semiconductor Inc. ("Anam") in Korea.
2. I was responsible for the filing of Korean Patent Application No. 99-13130, which was filed in the Korean Industrial Property Office ("KIPO") on April 14, 1999.
3. When the Korean application was filed, I believed that the inventors of the entire subject matter disclosed therein were Gi Jeong Kim, Seung Mo Kim, and Jin An Lee, and that the subject matter was invented at Anam in Korea. At that time, I did not know that Christopher J. de Simone or Lucian Hand had any involvement with the subject matter disclosed in the Korean application, or that any part of the subject matter was invented in the United States.
4. The subject matter disclosed in the Korean application is not under a United States government secrecy order, and was not under a United States government secrecy order at the time the Korean application was filed with the KIPO on April 14, 1999.

4. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application or any patent issuing therefrom.

Date: Feb. 14, 2000

 Feb. 14, 2000  
**TaeBok Jung**

EXPRESS MAIL LABEL NO:

EL 276258271US



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): de Simone, Christopher J., et al.  
Assignee: Amkor Technology, Inc. and Anam Semiconductor, Inc.  
Title: NONEXPOSED HEAT SINK FOR SEMICONDUCTOR PACKAGE  
Serial No.: TBD Filed: TBD  
Examiner: TBD Group Art Unit: TBD  
Docket No.: AB-928 US

Chandler, Arizona  
February 18, 2000

ATTN: LICENSING AND REVIEW  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D. C. 20231

**DECLARATION OF CHRISTOPHER J. DE SIMONE IN SUPPORT OF PETITION  
FOR RETROACTIVE FOREIGN FILING LICENSE**

I, Christopher J. de Simone, declare as follows.

1. I am employed by Amkor Technology, Inc. in Chandler, Arizona.
2. I conceived of the idea of a nonexposed heat sink for an integrated circuit package by at least September 1997. I initially conceived of the idea at Amkor's facility in Chandler, Arizona. By the first quarter of 1998, I was working on the idea with engineers at Anam Semiconductor Inc. ("Anam") in Korea. In Korea, I further developed and tested my idea. I also worked with engineers at Anam and developed ways to include it in a molded package.
3. I am informed that my concept of a nonexposed heat sink was included in Korean Patent Application No. 99-13130, which apparently was filed in the Korean Industrial Property Office on April 14, 1999. I was not in any way involved in the filing of the Korean patent application. At the time, I was involved in Amkor's process for initiating a U.S. patent application, but I was not aware that Anam intended to file or had already filed a Korean application. I learned the contents of the Korean application in around November 1999, when I reviewed a draft of a U.S. patent application that was based on the Korean application. It

appears that the Korean application included my concept of a nonexposed heat sink package with a leadframe and other package concepts invented by engineers at Anam.

4. My invention of a nonexposed heat sink is not under a United States government secrecy order, and was not under a United States government secrecy order at the time the Korean application was filed on April 14, 1999.

5. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application or any patent issuing therefrom.

Date:

2/18/2000

Christopher J. de Simone  
Christopher J. de Simone

EXPRESS MAIL LABEL NO:

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MacPHERSON, FRANKLIN  
& FRIED LLP

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